



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,660	06/13/2000	Neil W. Black	03797.86776	7450

28319 7590 04/06/2005
BANNER & WITCOFF LTD.,
ATTORNEYS FOR MICROSOFT
1001 G STREET, N.W.
ELEVENTH STREET
WASHINGTON, DC 20001-4597

EXAMINER

POINVIL, FRANTZY

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/592,660	Applicant(s) BLACK ET AL.	
	Examiner Frantzy Poinvil	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 17-28 and 30-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 17-28 and 30-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-8, 10-11, 17-19, 21-24, 26-28 and 30-48 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Shaughnessy et al. (US Patent No. 5,978,778).

As per claims 1 and 17, O'Shaughnessy et al disclose all the claimed invention particularly, a computer-implemented method for creating a portfolio comprising:

Receiving user input via a computer identifying specific issues to be added to the portfolio (column 14, lines 11-21);

Receiving user input via a computer input indicating a selection of one of a plurality of options for creating the portfolio (column 14, lines 22-28);

Receiving computer-input indicating a past date for purchase of the portfolio; and

Creating the portfolio and calculating the portfolio's past performance, using a computer based on said selection of one of said plurality of options and the past date.

Applicant is directed to column 14, lines 29-59 of O'Shaughnessy et al..

As per claims 2, 18, 39 and 44, O'Shaughnessy et al disclose receiving computer input indicating the selection includes receiving computer input indicating a selection of an option to allocate a number of shares for each issue. See column 14, lines 22-28 of O'Shaughnessy et al..

As per claims 5, 10 and 21 and 26, the number of shares for each issue is based on a weighting factor as calculated by the system of O'Shaughnessy et al. See column 14, lines 40-59 of O'Shaughnessy et al.

As per claims 3, 6-8, 19 and 22-24, 40, 41 and 45-46, O'Shaughnessy et al clearly teach the number of shares is constant for each issue and the selection includes receiving via a computer indicating an option to allocate an equal amount for the purchase of each issue and wherein the equal amount is selected by the user. See column 14, lines 22-28 and column 16, lines 52-58.

As per claims 7 and 23, O'Shaughnessy et al disclose said receiving computer input indicating the selection includes receiving computer input indicating a selection of an option to allocate a total amount for the portfolio. See column 14, lines 22-28 of O'Shaughnessy et al.

As per claims 11 and 27, O'Shaughnessy et al disclose providing a historical purchase price for each for each specific issue in the portfolio is obtained by the computer from a

historical database based on the past date. Note column 5, lines 35-57 and column 4, lines 7-25 of O'Shaughnessy et al.

As per claims 28, 38 and 43, O'Shaughnessy et al disclose a system for creating a portfolio of issues comprising:

An input system for receiving a designation of issues, for receiving a designation of an option fro creating the portfolio selected from a plurality of options, and receiving a historical price associated with each of said issues (column 5, lines 35-57 and column 4, lines 7-25)and ;

And a processor for determining the number of shares of the issues to add to the portfolio and past performance data relating to the portfolio based on the designated option and the historical price (column 14, lines 22-28) of O'Shaughnessy et al.

As per claims 30 and 34, O'Shaughnessy et al disclose a computer readable medium having a computer-executable program stored thereon for creating a portfolio of issues, the program comprising the steps of:

Receiving identification of specific issues to be added to the portfolio (column 14, lines 11-21);

Receiving identification of past closing date for the issue (column 3, line 20 to column 4, line 24) ;

Receiving historical prices for the specific issues based on the past closing date (column 3, line 20 o column 4, line 24);

Receiving a selection of a quantity of said specific issues and

Creating the portfolio based on the specific issues, the selected quantity of the specific issues and the historical prices. See column 14, lines 29-59 of O'Shaughnessy et al.

As per claims 31 and 35, O'Shaughnessy et al inherently disclose storing the portfolio on a client computer since the client or investor is making the selection for creating the portfolio.

As per claims 32 and 36, the computer-readable medium stores the portfolio on a server computer is also inherent in the system of O'Shaughnessy et al. since the selection is made from a server which inherently stores all clients' portfolios. See column 14, lines 60-67.

As per claim 33 and 37, O'Shaughnessy et al disclose receiving information regarding the specific issues. See columns 3-5.

As per claims 42 and 47, see column 13, line 55 to column 14, line 7 of O'Shaughnessy et al.

As per claim 48, O'Shaughnessy et al disclose a system for creating a portfolio of issues comprising:

An input system for receiving a designation of issues from a user and for receiving a designation of an option from a user for creating the portfolio selected from a plurality of options (see column 14, lines 11-20);

A processor for retrieving a price associated with each of the issues and for determining the number of shares of the issues to the portfolio based on the designated option and price is interpreted as stocks are selected and purchased in an evenly balanced portfolio. For example, if \$1,000,000 is invested in 50 stocks, \$20,000 is invested in each stock (column 14, lines 22-25). Automatically retrieving is not explicitly stated by O'Shaughnessy et al. However, O'Shaughnessy et al state that the system is an automated stock purchasing system for performing the automatic selection and purchasing of issues. See column 14, lines 53-55 and column 18, lines 4-18 of O'Shaughnessy et al.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 9, 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Shaughnessy et al (US Patent No. 6,018,722).

As per claims 4 and 20, the teachings of O'Shaughnessy et al are discussed above. O'Shaughnessy et al do not explicitly teach the number of shares is not constant for each issue. However, the Examiner notes that such would have been left to the user or investor. Thus, providing such a feature in the system of O'Shaughnessy et al would have been obvious to one of ordinary skill in the art in order to place a desired quantity of shares in the portfolio for each issue when placing a complete order or when creating the portfolio.

As per claims 9 and 25, O'Shaughnessy et al do not explicitly teach the amount is not equally divided between the issues. It would have been obvious to one of ordinary skill in the art at the time the invention was made to divide the amount unequally between the issues in the system of O'Shaughnessy et al. as such would have been dependent on the user when placing an order or creating the portfolio.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

Art Unit: 3628

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

FP
March 30, 2005


F. 